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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,199	06/09/2005	Guido Bold	ON/4-32798.A	1806
75/074 75/90 10/27/2009 NOVARTIS INSTITUTES FOR BIOMEDICAL RESEARCH, INC. 220 MASSACHUSETTS AVENUE CAMBRIDGE, MA 02139				
EXAMINER ROBINSON, BINTA M				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
10/27/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,199

Applicant(s)

BOLD ET AL.

Examiner

BINTA M. ROBINSON

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 23-27 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17, 23-27 and 30-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Detailed Action

The 103 (a) rejection over Manley, the 102 (b) rejection over Bold et. al., the 102 (e) rejection over Bold et. al., the 103 (a) rejection over Manley in view of Patani et. al., and the 112, second paragraph rejection of the phrase "if so desired" in claim 32 are rendered moot in light of applicant's amendments and remarks filed 7/13/09.

(old rejections)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 25-26, 30-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-12 of copending Application No. 11374720 (US PG Pub 20060178409). Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application teaches a method of treating retinopathy or age-related macula degeneration which are neoplastic diseases, with a genus of compounds which overlap is scope with the instant method of treating retinopathy or age-related

macula degeneration or treating the human or animal body or the treatment of a neoplastic disease, or the treatment of a neoplastic disease which responds to an inhibition of the VEGF-receptor tyrosine kinase activity.

Copending application 11374720 teaches the method for the treatment of retinopathy or age-related macula degeneration, of a neoplastic disease which responds to an inhibition of the VEGF-receptor tyrosine kinase activity with a compound of formula I wherein R1 represents H or lower alkyl, R2 represents H, R3 represents perfluoro lower alkyl, X is O or S. The difference between the copending method and the instantly claimed method is the teaching of a method which overlaps in subject matter with the instant method. It would have been obvious to one of ordinary skill in the art to select various known radicals within a genus to prepare structurally similar compounds for the same and/or similar uses. Accordingly, the methods of treating are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed methods over those of the generic copending methods.

(new rejections)

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 17, 23-27, 30-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claim 17, page 3, and everywhere else throughout the claims, the proviso

under the proviso that R cannot represent H if Z is nitrogen, X is hydroxy or methoxy and wherein the methylen group is attached to the pyridyl moiety at the carbon atom of the pyridyl moiety in 3-position, R₁ and R₂ cannot both represent H if Z is CH, R represents H, X is hydroxy, alkoxy or alkyl thio and wherein the methylen group is attached to the pyridyl moiety at the carbon atom of the pyridyl moiety in 3-position, and R₁ and R₂ cannot both represent H if Z is CH, R and R₂ both represent H, R₂ represents trifluoromethyl, X is bromo or hydroxy and wherein the methylen group is attached to the pyridyl moiety at the carbon atom of the pyridyl moiety in 4-position,

is unclear Z can never be nitrogen, yet Z equal to nitrogen is referred to in the proviso. It is also unclear when the proviso is only referring to Z equals CH.

Response to Applicant's remarks

The obvious double patenting rejection above is maintained because the applicant did not rebut the rejection or file a terminal disclaimer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0670.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

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/Binta M Robinson/
Examiner, Art Unit 1625

/Janet L. Andres/
Supervisory Patent Examiner, Art Unit 1625